

R E M A R K S

Applicants are grateful to the Examiner for the courtesy of participating in two Telephone Conversations with Applicants' representative on February 18, 2004.

In summary, Applicants' understanding (as explained in detail below) is that the rejection under 35 U.S.C. § 101 would be withdrawn if the claims were amended to recite a "computer or processor or module" in the body of the claims.

Discussion of pending claims

During the first Telephone Conversation, the Examiner and Applicants' representative discussed the status of claims in the present application. The Examiner confirmed that a Preliminary Amendment filed by Applicants concurrently with the present application (on November 8, 2001) had not been entered. The Preliminary Amendment had cancelled Claims 7-49, leaving only Claims 1-6 still pending. Applicants' representative stated that Applicants would expressly indicate that Claims 7-49 were cancelled in an Amendment & Response to the present Office Action.

Discussion of Section 101 rejection

The Examiner and Applicants' representative also discussed the Examiner's 35 U.S.C. § 101 rejection of Claims 1-6. During the first Telephone Conversation, the Examiner stated that the rejection could be overcome, as indicated in the present Office Action, by reciting a "computer or processor or module" in the body of the claims.

"Post-computer activity" and "post solution activity"

Applicants' representative asked the Examiner to explain the Examiner's finding that Claims 1-6 have "no post-computer activity" or "no post solution activity," and to explain the relevance of such findings to the Section 101 rejection.

In response, the Examiner stated that a "new paragraph" to be used for Section 101 rejections had been given to the Examiner after the mailing of the present Office Action.

The Examiner also stated that if the present Office Action had been mailed the day of the Telephone Conversations, the "new paragraph" addressing Section 101 would have replaced paragraph 2 on page 2 of the present Office Action (the "old paragraph").

The "new paragraph" (discussed further below) does not include any statement about "post-computer activity" or "post solution activity." In light of the Examiner's response, Applicants are unclear as to whether the asserted finding was actually made, or whether the statement was inadvertently retained when the Examiner used the "old paragraph" to make the Section 101 rejection.

The "new paragraph"

As noted above, the Examiner stated that a "new paragraph" to use in assessing patentability under Section 101 had been given to the Examiner by someone after the mailing of the present Office Action, and that the "new paragraph" was to replace use of the "old paragraph."

The Examiner volunteered to and did fax to Applicants' representative a copy of the "new paragraph" on February 18, 2004. A copy of the "new paragraph" is attached. Applicants are grateful to the Examiner for providing this courtesy.

After receiving and reviewing the copy of the “new paragraph,” Applicants’ representative called the Examiner to discuss the “new paragraph.” The Examiner agreed to discuss the “new paragraph” with Applicants’ representatives, for which Applicants are grateful.

During the second Telephone Conversation, the Examiner confirmed that the “new paragraph” was indicative of the change in policy of the U.S. Patent and Trademark Office (USPTO) regarding Section 101 rejections.

According to the Examiner, the “new paragraph” provided to the Examiner was drafted by employees of the USPTO responsible for implementing the change in policy. The Examiner indicated that such changes, including changes to “form paragraphs” for use in Office Actions, are customary and not infrequent, and that it is difficult to keep up with the changes.

Applicants’ representative asked the Examiner how the “new paragraph” regarding Section 101 rejections was communicated to the Examiner, if a “memo just showed up on your desk?” The Examiner responded affirmatively. Applicants understand by the Examiner’s response that the content of the “new paragraph” implementing the change in policy was provided to the Examiner in a paper memo.

The Examiner stated that he did not know exactly when he had received the “new paragraph.”

“Useful, concrete, tangible result”

During the second Telephone Conversation, the Examiner and Applicants’ representative discussed some of the content of the “new paragraph” provided by the Examiner.

The “new paragraph” includes two conditions that must be met for a claim to be statutory under 35 U.S.C. § 101: “1) In the claim, the practical application of an algorithm or idea result in a useful, concrete, tangible result, AND 2) The claim provides a limitation in the technological art that enables a useful, concrete, tangible result.”

The two conditions were not included in the “old paragraph” in the present Office Action. Applicants’ representative suggested that it would be expedient to discuss the requirement of “a useful, concrete, tangible result,” as according to the Examiner, the “new paragraph” reflected a change in policy (that the pending claims would be subject to in any subsequent Office Action).

The Examiner stated that the requirement of “useful, concrete, tangible result” means that a claim must specify the means by which a method can be used.

The Examiner suggested that Applicants amend Claims 1-6 to indicate that the process is “computerized,” which would satisfy the requirement of “a useful, concrete, tangible result.” The Examiner also stated that such an amendment would provide a “limitation in the technological art.”

As understood by Applicants, therefore, the Examiner indicated that both of the required conditions stated in the “new paragraph” would be satisfied if the claims were amended to indicate that the claimed processes are “computerized.”

Conclusion

If there remains any question regarding the present application, this Summary of Telephone Interview, or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

Respectfully submitted,



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Date